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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,315	10/22/2001	Kazuhiko Hachiya	112857-253	7385

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EXAMINER

BLACKWELL, JAMES H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,315

Applicant(s)

HACHIYA ET AL.

Examiner

James H. Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/22/01, 3/31/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to an amendment filed **02/21/2006** with a priority date of **12/20/1996**.
2. Claims 1, 9, 14, 18, 20, 28, 33, 37, 45, 50, 54, 56, 65, and 74 are independent claims.
3. Claims 72-82 are new claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5, 16, 24, 41, 52, 60, 69, and 78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.
6. Claim(s) 5, 16, 24, 41, 52, 60, 69, and 78 contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the term ***"learning function"*** is only mentioned once in the Specification (Pg. 12, line 10) with reference made that it would be defined/explained later in the Specification. However, the Examiner cannot identify any further reference or mention, or even suggestion anywhere in the Specification that defines what a learning function is, or how it functions. Therefore, the Examiner is unable to determine how to interpret these claims.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Specifically, the use of the term **"agent"** as depicted in Claims 1-82 renders those claims indefinite at least to the extent that it is confusing and unclear as to which entity, the sender or the receiver, or both are sending or receiving, or commanding, or modifying the agent or its annexed parameters. The Specification does distinguish between senders and receivers of email, but this is not necessarily made clear in the claim language. One possible way to distinguish the term would be to qualify whose agent, the sender or receiver, or both is performing the claimed limitations.

10. In addition, the use of the phrase **"agent is set to be absent"** (Claims 1, 9, 20, 28, 37, and 45) is unclear. First, does **"absent"** mean that it (the agent here understood to be an animated avatar) disappears, or that the agent ceases to execute, or both? In addition, does this occur on the sender-side, the recipient-side, or both?

11. This is also true when describing **"an absent state"** (as in Claims 11, 17, 30, 36, 47, and 53). The Specification appears to both generically describe the meaning of absent, as one of ordinary skill in the art would understand, and also to a specific definition where absent means that the post pet 103 is out, on the GUI picture of the PostPet (Room), which suggests a different definition depending on circumstances.

Additionally, it is unclear in the definition of an absent state listed above what is meant by the word **"out"**.

12. Claims 8, 13, 27, 32, 44, and 49, refer to a condition where **"if an agent is absent, an agent which can be designated sending plural emails"**. The claim language is unclear as to whether or not the two instances of the term, as listed in the claim are the same agent, or are different agents. From the Specification, and particularly Fig. 3, it would appear that there are two separate agents available (103A, and 104). However, the claim language does not adequately distinguish the two, if indeed there are two.

13. Claims 64, 73, and 82 recite the limitation **"image data"**. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. The claimed invention is directed to non-statutory subject matter. Specifically, independent Claims 37, 45, 50, and 74 sets forth **"a program supplying medium for supplying an E-mail receiving program that can be read out and executed by a computer"** that is not clearly set forth as being implemented on a computer or computer-readable-medium. The scope of the claim amounts to nothing more than applications. At best, the claim would read on an E-mail receiving program per se, which does not constitute statutory subject matter.

Allowable Subject Matter

16. Claims 37, 45, 50, and 74 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

17. Claims 1, 9, 14, 18, 20, 28, 33, 37, 45, 50, 56, 65, and 74 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

18. Claims 2-8, 10-13, 15-17, 19, 21-27, 29-32, 34-36, 38-44, 46-49, 51-53, 55, 57-64, 66-73, and 75-82 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

19. Applicant's arguments, see Amendment, filed 02/21/2006, with respect to the rejection(s) of claim(s) 1-71 under Cook in view of Hussey have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
04/15/2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
4/17/2006